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Filed : February 8, 2002

### REMARKS

This paper cancels Claims 36-39, 41-43 and 52-67 and adds new Claims 68-91. Claims 1-35, 40 and 44-51 were previously canceled. Claims 68-91 are pending. Reconsideration and allowance of the claims is respectfully requested. Applicant has amended the title. Applicant has rewritten the claims for clarification, and not to avoid any prior art and not to narrow the claims.

#### Discussion of the New Matter Objection under 35 USC § 132(a)

The amendment filed December 5, 2005 was objected to under 35 U.S.C. § 132(a), which states that no amendment shall introduce new matter into the disclosure of the invention. Applicant respectfully submits that the amendment filed December 5, 2005 does not introduce new matter. The term "idea shares" is disclosed at page 41, lines 5-8 of the specification and in Figure 4B, Figure 55A and Figure 55B. In fact, the term "idea shares" is used thirteen times in Figures 55A and 55B. In the amendment filed December 5, 2005, pages 41-42 and Figures 56-60 were amended to conform to the description of idea shares disclosed at page 41, lines 5-8 of the specification and in Figure 4B, Figure 55A and Figure 55B. For example, Figure 55B describes that "prospective buyers of patent rights may wish to purchase idea shares to the ideas...". Figures 56-60 and the related text in the specification describe how the idea shares concept described on page 41 and Figures 55A and 55B can be utilized.

#### Discussion of Claim Rejection under 35 USC § 112, 1<sup>st</sup> ¶

Claims 36-49, 41-43 and 52-67 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement and as failing to comply with the enablement requirement. In response, Applicant has canceled the rejected claims and has provided new claims to comply with the written description requirement and the enablement requirement.

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Discussion of Claim Rejection under 35 USC § 112, 2<sup>nd</sup> ¶

Claims 36-49, 41-43 and 52-67 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, Applicant has canceled the rejected claims and has provided new claims to correct the indefiniteness.

The Office Action specifically stated: "What does the term marketed in an online marketable format mean?" New Claim 70 now recites in part: "marketing at least some of the contractual rights on-line in a marketable format". Applicant respectfully invites the Examiner to review Figure 55 and the associated Figures 56-60 that enable the concepts of Figure 55 to be performed in a computerized online environment. Reference is also respectfully requested to pages 41-42 of the specification. Some embodiments are described at page 41, lines 3-8 as follows. "In some preferred embodiments, the computer system 21 is programmed to enable transfer of contingent contractual rights 40 in a marketable format between an owner of contingent property rights 40 and another interested party. One embodiment of such a marketable format is described in the About IDEA SHARES screen display shown in FIG. 55, which may be accessed by clicking the About Idea Shares link in the About IDEA SPACE screen display shown in FIG. 4B."

The Office Action also specifically stated: "What does the applicant mean by the format is an electronically tradable certificate?" Applicant respectfully invites the Examiner to review an embodiment described in Figure 55 and the associated Figures 56-60 that enable the concepts of Figure 55 to be performed in a computerized online environment for facilitating electronic trading. Some embodiments are further described at page 14, lines 11-17 of the specification as follows. "In some embodiments, the computer system 21 is programmed to systematically provide the contributors of ideas with contingent contractual rights 40 to at least some inventions derived at least in part from the ideas accumulated in the database 22, and to facilitate provision of such contingent rights in a marketable format, such as an electronically tradable certificate, by on-line communications between the computer system 21 and the contributor computers 27, or as described below with reference to FIGS. 55-60." For example, a certificate can be representative of the Idea Shares of Figures 55A and 55B, which can be traded electronically.

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**To Anticipate a Claim, the Reference Must Teach Every Element of the Claim**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsisimilis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Discussion of Rejection of Claims Under 35 U.S.C. § 102(e)

Claims 36-39, 41-43 and 52-67 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Powell (Publication No. US 2004/0220881 A1).

Claim 68 recites (and similarly in the other independent claims) in part:

- (b) providing contractual rights to contributors of the idea contributions or to parties specified by the contributors, in exchange for property rights to prospectively patentable inventions derived at least in part from the accumulated idea contributions, or in exchange for contractual obligations by the contributors to provide the property rights, wherein the contractual rights are to a portion of income associated with the property rights; and
- (c) providing at least one of the contractual rights from at least one of the contributors or from at least one of the parties specified by the at least one contributor to at least one other party.

Powell does not disclose providing contractual rights from contributors or parties specified by contributors. Powell does not disclose providing contractual rights to parties other than contributors. Applicant recites the additional and very different act of providing contractual rights from contributors or parties specified by contributors to other parties. Therefore, each and every element as set forth in the claim is not found in Powell and, therefore, Powell does not anticipate the claim.

New Claims 74 and 80 are related to Claim 42. Regarding Claim 42, the Office Action states that "Powell discloses accumulating ideas prior to filing a patent application". Claims 74

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and 80 do not recite accumulation prior to filing a patent application. Claim 74 recites in part: “prior to filing any patent applications for any particular inventions derived at least in part from the accumulated idea contributions, publishing the accumulated idea contributions that the particular inventions are derived from.” Powell does not disclose publishing ... prior to filing as claimed by Applicant, and, therefore, Powell cannot be used to anticipate new Claims 74 and 80.

Applicant submits that there was no specific anticipation rejection of Claims 52 and 53. New Claims 76, 79, 83, 88 and 91 are similar to Claims 52 and 53, and therefore, should not be rejected as anticipated by Powell.

#### Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. Claims 69-76, 78-80, 82-85 and 87-90 are dependent either directly or indirectly on the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

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Conclusion

In view of the foregoing remarks, Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/27/06

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